

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/445,218	01/28/00	ROSSI	C 3687-2

NIXON & VANDERHYE
1100 NORTH GLEBE ROAD
8TH FLOOR
ARLINGTON VA 22201-4714

HM22/0404

EXAMINER

OSWECKI, J

ART UNIT

PAPER NUMBER

1626

DATE MAILED:

04/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/445,218

Applicant(s)
Carla Rossi

Examiner
Jane Oswecki

Group Art Unit
1626



☒ Responsive to communication(s) filed on Feb 14, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 28-48 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 28-36, 38, and 41-46 is/are rejected.

☒ Claim(s) 37, 39, 40, 47, and 48 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Jane Oswecki
JANE OSWECKI
PRIMARY EXAMINER
ART UNIT 1626

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1626

DETAILED ACTION

Claims 28-48 are pending in the application. Claims 1-27 have been canceled by amendment. All cited references have been considered and any cited but not applied are cited to show the state of the art. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102(b)

Claims 28-36, 38 and 41-46 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 4,353,090 to Galliani et al. ("Galliani").

The applicant claims optionally substituted diphenyl-1,2,4-triazole derivative compounds which have antigestative, antitumor and immunosuppressant activity.

Galliani discloses optionally substituted 3,5-diphenyl-1H-1,2,4-triazole derivative compounds, compositions comprising and methods of using the compounds as antigestative agents (U.S. 4,535,090, Abstract). The compounds disclosed by Galliani are identical to those instantly claimed where the instant substituents have the following meanings: "R" is H or -COR₈ and R₈ is saturated or unsaturated hydrocarbon of C₁₋₁₀; "R₁" is phenyl substituted by lower alkyl or alkoxy or substituents on phenyl join to form a methylenedioxy group; "R₂" is phenyl-CH₂OR₅ and R₅ is -C(=O)-Z where Z is O-aliphatic chain, the aliphatic chain being C₅₋₂₀ hydrocarbonyl, saturated or unsaturated (see U.S. 4,535,090, Abstract). Thus, Galliani anticipates the claims 28-36, 38 and 41-46.

Art Unit: 1626

Claim Rejections - 35 USC § 103

Claims 28-36, 38 and 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 4,535,090, to Galliani et al. ("Galliani").

The applicant claims optionally substituted diphenyl-1,2,4-triazole and optionally substituted diphenyl-imidazole derivative compounds that may have carbonate, carbamate and/or phosphate substituents among other substituent groups. The instant compounds have antitumor, antigestative and immunosuppressant activity.

To any extent that U.S. 4,535,090 may be found not to anticipate claims 28-36, 38 and 41-46, these same claims are rendered obvious by Galliani.

Galliani teaches optionally substituted 3,5-diphenyl-1H-1,2,4-triazole derivative compounds, compositions comprising and methods of using these compounds as antigestative agents (U.S. 4,535,090, Abstract). The compounds taught by Galliani are like those instantly claimed where the instant substituents have the following meanings: "R" is H or -COR₈ and R₈ is saturated or unsaturated hydrocarbon of C₁₋₁₀; "R₁" is phenyl substituted by lower alkyl or alkoxy or substituents on phenyl join to form a methylenedioxy group; "R₂" is phenyl-CH₂OR₅ and R₅ is -C(=O)-Z where Z is O-aliphatic chain and where the aliphatic chain is C₅₋₂₀ hydrocarbyl, saturated or unsaturated (U.S. 4,535,090, Abstract). Galliani does not teach antigestative compounds that are diphenyl-imidazole derivatives; diphenyl-imidazole or diphenyl-triazole derivative compounds that have a phosphorus or phosphate substituent; nor the use of these compounds in the treatments of tumors and/or immunological responses.

Art Unit: 1626

It would have been obvious to one skilled in the art of antigestative compounds to have utilized the teachings of Galliani et al. A skilled artisan would have been motivated to do so in the expectation that compounds of similar structure would exhibit similar properties.

Claim Objections

Claims 37, 39, 40, 47 and 48 are objected to as being dependent upon a rejected base claim.

Response to Amendments

The applicant's amendments filed February 14, 2001 in Paper No.7 is sufficient to overcome the rejections of claims 15 and 16 under 35 U.S.C. 101; claims 1-15, 17, 19, 21, 22, 25 and 26 under 35 U.S.C. 102(b) over EPO 080,053 to Gruppo Lepetit S.p.A. ("Galliani et al.") and U.S. 4,535,090 to Galliani et al.; claims 1-17, 19-22, 25 and 26 under 35 U.S.C. 103(a) over EPO 080,053 to Gruppo Lepetit S.p.A. ("Galliani et al."), U.S. 4,535,090 to Galliani et al., FR 2,440,364 to Gruppo Lepetit S.p.A. ("Omodei-Sale et al."), and U.S. 4,888,350 and U.S. 4,459,302, both Omodei-Sale et al.; claims 1, 19, 20, 23 and 24 under 35 U.S.C. 112, first paragraph; claims 1 and 19-24 under 35 U.S.C. 112, second paragraph; the objections to claims 1-21 and 23-27; the objection to the specification for lack of an abstract and need for substitute pages 6-9, 15, 21, 24, 26, 27, 34, 42-45a, 52 and 53. The rejections and objections made on these bases are withdrawn.

Response to Arguments

Art Unit: 1626

The applicant's arguments in Paper No. 7 filed February 14, 2001 have been fully considered and are deemed persuasive to overcome the rejections of claims 15 and 16 under 35 U.S.C. 101; claims 1-15, 17, 19, 21, 22, 25 and 26 under 35 U.S.C. 102(b) over EPO 080,053 to Gruppo Lepetit S.p.A. ("Galliani et al.") and U.S. 4,535,090 to Galliani et al.; claims 1-17, 19-22, 25 and 26 under 35 U.S.C. 103(a) over EPO 080,053 to Gruppo Lepetit S.p.A. ("Galliani et al."), U.S. 4,535,090, to Galliani et al., FR 2,440,364 to Gruppo Lepetit S.p.A. ("Omodei-Sale et al."), and U.S. 4,888,350 and U.S. 4,459,302, both Omodei-Sale et al.; claims 1, 19, 20, 23 and 24 under 35 U.S.C. 112, first paragraph; claims 1 and 19-24 under 35 U.S.C. 112, second paragraph; the objections to claims 1-21 and 23-27; the objection to the specification for lack of an abstract and need for substitute pages 6-9, 15, 21, 24, 26, 27, 34, 42-45a, 52 and 53.

Applicant's arguments and provisos are not persuasive, however, to overcome the presence of structural components found in both this application and the prior art reference U.S. 4,353,090 to Galliani et al. Therefore, claims 28-36, 38 and 41-46 stand rejected. Claims 37, 39, 40, 47 and 48 are objected to.

Remarks

This application lacks a certified copy or copies of priority documents.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1626

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Oswecki, whose telephone number is (703) 305-7152. The examiner can normally be reached on Monday-Thursday from 7:30 AM - 5:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Art Unit: 1626

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.


Jane Oswecki
Primary Examiner
Art Unit 1626

03 April 2001